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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,080	03/29/2001	Dwip N. Banerjee	AUS920010178US1	5334
45440	7590	03/16/2005	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,080

Applicant(s)

BANERJEE ET AL

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-38 have been examined.

Response to Amendment

2. The Amendment filed on 1/12/05 is sufficient to overcome the Fajkowski reference as a 35 USC 102 rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (5,905,246).

Claim 1, 12, 23, 28: Fajkowski discloses a method, server, system, medium comprising:
maintaining an e-coupon database that comprises an e-coupon identifier, an e-coupon expiration condition, and a post-expiration instruction (col 1, lines 5-10; col 3, lines 50-55);

receiving a request to redeem the e-coupon associated with the e-coupon identifier when the e-coupon is expired; and

executing the post-expiration instruction associated with the e-coupon identifier (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

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Additionally, Fajkowski discloses maintaining instructions for maintaining an e-coupon database on a server (Fig. 1; col 8, lines 1-6) that comprises an e-coupon identifier (col 1, lines 7-15), an e-coupon expiration condition (Fig. 4b, the expiration date).

Fajkowski further discloses receiving coupons over the Internet (col 6, lines 20-46) including Internet sites (col 29, lines 59-67).

Note that cashier has access to a local processor via the periphery device and that the local processor of the cashier is in communication with the server (Fig. 1; col 4, line 15-63; col 8, lines 1-7). Note that the processor of the periphery device can receive consumer requests to redeem e-coupons and that the periphery device can execute instructions associated with the e-coupons. For example, the processor of the periphery device can accept or not accept the e-coupon depending upon how the processor is instructed.

The following is in regards to post-expiration instructions in a database on a server.

Fajkowski further discloses utilizing a database, server, and coupon related information (col 4, line 64- col 5- col 5, lines 57).

Fajkowski discloses that post-expiration instructions (the raincheck marker) can be placed on e-coupons on the user's card that has e-coupons (col 20, lines 45-55; col 20, lines 36-40).

Fajkowski further discloses that records of coupons including special redemption instructions are maintained by the database server on the clearinghouse server (col 23, lines 47-65). Fajkowski discloses records of coupon information and redemption instructions including 'raincheck' markers (col 10, lines 30-49). Note that the post-expiration instructions can include

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whether the coupon can still be redeemed or not. Fajkowski further discloses maintaining user information related to coupons at the database on a server (col 8, lines 40-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Fajkowski's clearinghouse server that maintains redemption instructions can include the redemption instructions for post-expiration or raincheck markers. One would have been motivated to do this because redemption instructions are placed on the card and redemption instructions also includes raincheck markers information placed on the card (col 10, lines 30-49).

Claim 2, 13, 29: Fajkowski discloses the method of claim 1, further comprising issuing the e-coupon from an e-coupon server (col 4, line 64-col 5, line 39).

Claim 3, 14, 30: Fajkowski discloses the method of claim 2.

Fajkowski further comprising configuring the e-coupon server through a user interface (Fig. 1; col 4, line 64-col 5, line 39; col 1, lines 5-15).

Fajkowski further discloses utilizing a graphical user interface (col 6, lines 44-60; col 31, lines 14-26; Fig. 20a).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Fajkowski can configure the e-coupon server utilizing a graphical user interface. One would have been motivated to do this in order to provide a convenient way for e-coupon configuring.

Claim 4-6, 15-17, 24-27, 31-33: Fajkowski's discloses the method of claim 1.

Fajkowski further discloses that the post-expiration instruction is selected from the group consisting of rejecting the e-coupon, fully redeeming the e-coupon, partially redeeming the e-

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coupon, issuing an alternative e-coupon, and combinations thereof (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Fajkowski does not explicitly disclose partially redeeming the coupon.

However, Fajkowski discloses that coupons can be varied in numerous ways, including varying the discount amount, and adjusted to particular users and also immediately redeemed after an adjustment (col 5, lines 36-65; col 24, lines 45-54) and that a variety options or coupons can be offered when an expired coupon is presented for redemption (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Fajkowski's offer when an expired coupon is presented can be for redeeming the coupon for a different value. One would have been motivated to do this in order to maintain the loyalty of customer deemed valuable.

Fajkowski further discloses that the post-expiration instruction comprises issuing an alternative e-coupon for a product selected from the same product and a substitute product (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Fajkowski's further discloses that the e-coupon database further comprises an estimated value of the coupon, and wherein the post-expiration instruction comprises issuing an alternative e-coupon with an estimated value in proportion to the expired e-coupon (col 16, line 60-col 17,

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line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Claim 7, 18, 34: Fajkowski discloses the method of claim 1, wherein the expiration condition is an expiration date (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Claim 8, 19, 35: Fajkowski discloses the method of claim 1, further comprising: executing the post-expiration instruction only if one or more transaction conditions are true (col 16, line 60-col 17, line 21; col 19, line 50-col 20, line 10; col 20, line 34-col 21, line 6; col 33, lines 35-40; col 35, lines 24-39).

Claims 9, 20, 36 and 10, 21, 37: Fajkowski discloses the method of claim 8.

Fajkowski further discloses tracking a consumer profile for marketing purposes and tracking return customer activity (col 5, lines 30-39; col 3, lines 40-50; col 24, lines 45-54).

Fajkowski further discloses that the cashier can utilize override codes or arbitrary decisions to accept an expired coupon (col 19, line 64-col 20, line 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the override codes to redeem an expired coupon can be determined by consumer profile or history. One would have been motivated to do this in order to market to and retain consumer considered desirable.

Claim 11, 22, 38: Fajkowski discloses the method of claim 1, wherein the request to redeem an e-coupon is received from a consumer using a graphical user interface (col 6, lines 44-60; col 31, lines 14-26; Fig. 20a).

Response to Arguments

4. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the 35 USC 103(a) rejection.

In Applicant's Amendment dated 1/12/05 starting on page 9, Applicant states:

"First, Fajkowski fails to disclose a database on a server that includes an e-coupon identifier, an e-coupon expiration condition and a post-expiration instruction.

Fajkowski discloses a clearinghouse database on a server but fails to disclose that the clearinghouse database maintains post-expiration instructions. . .Fajkowski does not disclose that the database includes a post-expiration instruction. . .

Secondly, Fajkowski fails to describe executing the post-expiration instruction associated with the e-coupon. . .The disclosure by Fajkowski does not disclose executing the post-expiration instruction stored in the server database. Furthermore, since Fajkowski fails to disclose a database on a server having a post-expiration instruction, Fajkowski cannot disclose executing the post-expiration instruction."

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

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See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Hence, the receiving and executing steps of claim 1 can be performed fully or partially by the assistance of manual or human intervention. While the maintaining step of claim 1 explicitly states the utilization of a database on a server, the receiving and executing steps do not explicitly state the utilization of a computer related technology. Hence, the receiving and executing steps of claim 1 can be performed fully or partially by the assistance of manual or human intervention.

Claim 23 more explicitly states the use of technology in all the method steps. The utilization of the processor in claim 23 is addressed below.

Please also note that the additional citations added below have also been added to the rejection above.

Fajkowski discloses maintaining instructions for maintaining an e-coupon database on a server (Fig. 1; col 8, lines 1-6) that comprises an e-coupon identifier (col 1, lines 7-15), an e-coupon expiration condition (Fig. 4b, the expiration date).

Fajkowski further discloses receiving coupons over the Internet (col 6, lines 20-46) including Internet sites (col 29, lines 59-67).

Note that cashier has access to a local processor via the periphery device and that the local processor of the cashier is in communication with the server (Fig. 1; col 4, line 15-63; col 8, lines 1-7). Note that the processor of the periphery device can receive consumer requests to redeem e-coupons and that the periphery device can execute instructions associated with the e-coupons. For example, the processor of the periphery device can accept or not accept the e-coupon depending upon how the processor is instructed.

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Fajkowski further discloses that records of coupons including special redemption instructions are maintained by the database server on the clearinghouse server (col 23, lines 47-65). Fajkowski discloses records of coupon information and redemption instructions including 'raincheck' markers (col 10, lines 30-49). Note that the post-expiration instructions can include whether the coupon can still be redeemed or not. Fajkowski further discloses maintaining user information related to coupons at the database on a server (col 8, lines 40-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Fajkowski's clearinghouse server that maintains redemption instructions can include the redemption instructions for post-expiration or raincheck markers. One would have been motivated to do this because redemption instructions are placed on the card and redemption instructions also includes raincheck markers information placed on the card (col 10, lines 30-49).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
2/25/05



JEFFREY D. CARLSON
PRIMARY EXAMINER